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Docket 84196CTJS
Customer No. 01333

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Loretta E. Allen, et al

IMPROVED LABEL AND
METHOD OF MAKING

Serial No. 10/761,671

Filed January 21, 2004

Group Art Unit: 3722

Examiner: Mark T. Henderson

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Sir:

APPEAL BRIEF TRANSMITTAL

Enclosed herewith is Appellants' Appeal Brief for the above-identified application.

The Commissioner is hereby authorized to charge the Appeal Brief filing fee to Eastman Kodak Company Deposit Account 05-0225. A duplicate copy of this letter is enclosed.

Respectfully submitted,

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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.



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APPEAL BRIEF PURSUANT TO 37 C.F.R. 41.37 and 35 U.S.C. 134

02/06/2007 GWORDOF1 00000050 050225 10761671

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APPELLANT'S BRIEF ON APPEAL

Appellant hereby appeals to the Board of Patent Appeals and Interferences from the Examiner's Final Rejection of claims 1-7, 9 and 11 which was contained in the Office Action mailed September 18, 2006.

A timely Notice of Appeal was filed November 3, 2006.

Real Party In Interest

As indicated above in the caption of the Brief, the Eastman Kodak Company is the real party in interest.

Related Appeals And Interferences

No appeals or interferences are known which will directly affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

Status Of The Claims

Claims 1-7, 9 and 11 are pending in the application. Claim 8, 10, 12 and 13 are cancelled.

Appendix I provides a clean, double spaced copy of the claims 1-7, 9 and 11 on appeal.

Status Of Amendments

A 116 response was entered by the Examiner subsequent to the Final Office Action mailed on September 18, 2006.

Summary of Claimed Subject Matter

Claim 1

Independent claim 1 is directed to a media. More particularly, the invention includes an image-receiving layer 26 having a first machine-readable indicia 32 thereon. *See* page 17, line 29 – page 18, line 8 and Fig. 9; page 6, lines 26-30. Further, the invention includes a protective overlayer 14 selectively applied on said image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon. *See* page 13, line 11 - page 15, line 2. The second

machine-readable indicia being identical to and superimposed over said first machine-readable indicia. *See* page 17, line 29 – page 18, line 8 and Fig. 9

Claim 2

Independent claim 2 is directed to a media. More particularly, the invention includes an image-receiving layer 26 having a first machine-readable indicia 32 thereon using a thermal head. *See* page 17, line 29 – page 18, line 8 and Fig. 9; page 6, lines 26-30; page 13, lines 1-4 and Figs 1-3. Further a protective overlayer selectively applied on said image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon using a thermal head. *See* page 13, line 11 - page 15, line 2; page 13, lines 1-4 and Figs 1-3. The second machine-readable indicia being identical to and superimposed over said first machine-readable indicia. *See* page 17, line 29 – page 18, line 8 and Fig. 9

Claim 6

Independent claim 6 is directed to a media. More particularly, the invention includes a 1st machine-readable indicia 32 in an image layer 28 on said media. *See* page 17, line 29 – page 18, line 8 and Fig. 9; page 6, lines 26-30. Further, the invention includes a protective overlayer selectively applied on said image layer to form a 2nd machine-readable indicia of varying thicknesses that is identical in content to, and in register with said 1st machine-readable indicia in said image layer. *See* page 13, line 11 - page 15, line 2; *See* page 17, line 29 – page 18, line 8 and Fig. 9. The 2nd machine-readable indicia being integrally formed during application of said protective overlayer over said image layer. *See* page 13, line 11 - page 14, line 17.

Claim 7

Independent claim 7 is directed to a label. More particularly, the invention includes an image-receiving layer 28 having a visual image formed thereon using a thermal head. *See* page 17, line 29 – page 18, line 8 and Fig. 9; page 6, lines 26-30. Further, the invention includes a protective overlayer selectively applied on said image-receiving layer to form a machine-readable indicia of varying

thicknesses. *See* page 13, line 11 - page 15, line 2. The machine-readable indicia being substantially transparent but is capable of being machine-readable. *See* page 14, lines 30-32.

Grounds of Rejection to be Reviewed on Appeal

The following issues are presented for review by the Board of Patent Appeals and Interferences:

1. Whether the invention of claims 1-7, 9 and 11 are patentable under 35 USC §103(a) over Zeiter et al. (6,494,491) in view of Dukatz (6,113,149). Appellant respectfully traverses the rejections.

Arguments

1. §103(a) Rejection of Claims 1-7, 9 and 11 over Zeiter et al. (6,494,491) in view of Dukatz (6,113,149)

Claims 1-6 and 11

First, Zeiter fails to teach or suggest at least a protective overlayer selectively applied on said image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon as required by Appellant's independent claims. In construing claims, the court in *Phillips* has recently emphasized that "claims must be read in view of the specification." *Phillips v. AWH Corp.*, 415 F.3d 1303,1315 (Fed. Cir. 2005). In fact, the Federal Circuit explained that the specification is "usually . . .dispositive. . . [and] the single best guide to the meaning of a disputed term." *Id.* (quoting *Vitronics Corp. v. Conceptronic, Inc.*, 90 F.3d 1576, 1582). For these reasons, the Federal Circuit confirmed that it is "entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Phillips*, 415 F.3d at 1317. Zeiter discloses that a transparent plastic film 10 has images 12, 14 on both sides a distance d apart. *See* Col. 5, lines 23-25. At best, Zeiter discloses overlapping images separated by a plastic film in which additional uniform outer layers 22, 24 can be laminated onto the plastic film. *See* Col. 6, lines 9-12. Zeiter's transparent layer 10 is not selectively applied on an image-receiving layer to form a second machine-

readable indicia of varying thicknesses thereon. Appellant respectfully disagrees with the Office Action's assertion that "the protective overlayer (10) further comprises a second identical image indicia (14) superimposed over the first image indicia." Appellant submits that "FIG. 3 of Zeiter shows a transparent plastic film 10 made up of two film layers 10a, b. The images 12, 14 have been printed on the outer faces of the film layers 10a, b." *See* Col. 5, lines 55-57.

Dukatz fails to remedy the deficiencies of Zeiter as Dukatz also fails to teach or suggest at least a protective overlayer selectively applied on said image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon. Rather, Dukatz merely provides a textured pattern 18 formed an image 16. A protective transparent layer 20 is then laminated over the textured pattern 18. A second textured layer 22 is formed over all or a portion of the transparent layer 20 using screen-printing. *See* Col. 3, line 36 – Col. 4, line 62. Further, Appellant agrees with the Final Office Action's assertion that the second textured layer 22 is "not directly" formed on the textured pattern 18. *See* page 5 of the Final Office Action. Accordingly, Dukatz does not provide a protective overlayer selectively applied on an image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon.

Second, Zeiter fails to teach or suggest at least a second machine-readable indicia. Rather, Zeiter discloses that as additional security one may employ colors that make a moiré pattern visible only under UV or IR light. *See* Col. 2, lines 61-65. Accordingly, Zeiter does not disclose an indicia being readable by a machine.

Dukatz fails to remedy the deficiencies of Zeiter as Dukatz also fails to teach or suggest at least a second machine-readable indicia. Rather, Dukatz merely provides a textured pattern 18 formed an image 16. A protective transparent layer 20 is then laminated over the textured pattern 18. A second textured layer 22 is formed over all or a portion of the transparent layer 20 using screen-printing. *See* Col. 3, line 36 – Col. 4, line 62. However, Dukatz does not disclose that the protective layer 20 is a machine-readable indicia.

Further, Appellant submits that Appellant's protective overlayer forming machine-readable indicia of varying thicknesses is novel and unobvious

in that it has structure and function, which is required for patentability. Appellant submits that the protective overlayer selectively applied on the image-receiving layer to form a second machine-readable indicia of varying thicknesses enhances the machine readability. This specifies at least the required functional relationship to carry out Appellant's invention and clearly defines the disclosed invention as required by section 112. "The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination." *In re Miller*, 418 F.2d 1392, 1395; 164 USPQ 46, 48 (1969).

In view of the above remarks, Appellant respectfully submits that claims 1, 2 and 6 are patentable over the cited references. Because claims 3-5 and 11 depend from claim 2, and include the features recited in the independent claims as well as additional features, Appellant respectfully submits that claims 3-5 and 11 are also patentably distinct over the cited references.

Claims 7 and 9

First, Zeiter fails to teach or suggest at least a protective overlayer selectively applied on said image-receiving layer to form a machine-readable indicia of varying thicknesses. Rather, Zeiter discloses that a transparent plastic film 10 has images 12, 14 on both sides a distance d apart. *See* Col. 5, lines 23-25. At best, Zeiter discloses overlapping images separated by a plastic film in which additional uniform outer layers 22, 24 can be laminated onto the plastic film. *See* Col. 6, lines 9-12. Zeiter's transparent layer 10 is not selectively applied on an image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon. Appellant respectfully disagrees with the Office Action's assertion that "the protective overlayer (10) further comprises a second identical image indicia (14) superimposed over the first image indicia." Appellant submits that "FIG. 3 of Zeiter shows a transparent plastic film 10 made up of two film layers 10a, b. The images 12, 14 have been printed on the outer faces of the film layers 10a, b." *See* Col. 5, lines 55-57. However, Zeiter does not disclose a protective overlayer selectively applied on said image-receiving layer to form a machine-readable indicia of varying thicknesses.

Dukatz fails to remedy the deficiencies of Zeiter as Dukatz also fails to teach or suggest at least a protective overlayer selectively applied on said image-receiving layer to form a machine-readable indicia of varying thicknesses. Rather, Dukatz merely provides a textured pattern 18 formed an image 16. A protective transparent layer 20 is then laminated over the textured pattern 18. A second textured layer 22 is formed over all or a portion of the transparent layer 20 using screen-printing. *See* Col. 3, line 36 – Col. 4, line 62. Dukatz does not disclose that the protective layer 20 is selectively applied on an image-receiving layer to form a second machine-readable indicia of varying thicknesses.

Second, Zeiter fails to teach or suggest at least a second machine-readable indicia. Rather, Zeiter discloses that as additional security one may employ colors that make a moiré pattern visible only under UV or IR light. *See* Col. 2, lines 61-65. Accordingly, Zeiter does not disclose an indicia being readable by a machine.

Dukatz fails to remedy the deficiencies of Zeiter as Dukatz also fails to teach or suggest at least a second machine-readable indicia. Rather, Dukatz discloses a textured pattern 18 on an image layer 16. A protective layer 20 is then formed on the textured pattern 18. However, Dukatz does not disclose machine-readable indicia.


In view of the above remarks, Appellant respectfully submits that claim 7 is patentable over the cited references. Because claim 9 depend from claim 7 and includes the features recited in the independent claim as well as additional features, Appellant respectfully submits that claim 9 is also patentably distinct over the cited references.

Conclusion

For the above reasons, Appellant respectfully requests that the Board of Patent Appeals and Interferences reverse the rejection by the Examiner and mandate the allowance of Claims 1-7, 9 and 11.

Respectfully submitted,

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If the Examiner is unable to reach the Appellant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.

Appendix I - Claims on Appeal

1. A media comprising:

an image-receiving layer having a first machine-readable indicia thereon; and

a protective overlayer selectively applied on said image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon, said second machine-readable indicia being identical to and superimposed over said first machine-readable indicia.

2. A media comprising:

an image-receiving layer having a first machine-readable indicia thereon using a thermal head; and

a protective overlayer selectively applied on said image-receiving layer to form a second machine-readable indicia of varying thicknesses thereon using a thermal head, said second machine-readable indicia being identical to and superimposed over said first machine-readable indicia.

3. The media of claim 2 wherein said second machine-readable indicia being transparent so as to allow viewing of an image provided on said image-receiving layer.

4. The media of claim 2 wherein said protective overlayer comprises an IR absorbing dye.

5. The media of claim 2 further comprising an adhesive layer for securing to an item.

6. A media comprising:
a 1st machine-readable indicia in an image layer on said media; and
a protective overlayer selectively applied on said image layer to form a 2nd machine-readable indicia of varying thicknesses that is identical in content to, and in register with said 1st machine-readable indicia in said image layer, said 2nd machine-readable indicia being integrally formed during application of said protective overlayer over said image layer.

7. A label comprising:
an image-receiving layer having a visual image formed thereon using a thermal head; and
a protective overlayer selectively applied on said image-receiving layer to form a machine-readable indicia of varying thicknesses, said machine-readable indicia being substantially transparent but is capable of being machine-readable.

9. A media according to claim 7 wherein said machine-readable code comprises a bar code.

11. A media according to claim 2 wherein said machine-readable code comprises a bar code.

NONE

Appendix II - Evidence

Appendix III – Related Proceedings

NONE